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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/504,159
Filing Date: February 15, 2000
Appellant(s): VAIDYANATHAN ET AL.

Kent J. Sieffert
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 10, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The Examiner disagrees with the summary of the claimed subject matter contained in the brief. It appears that the Appellant for the purposes of the appeal brief has introduced new and more limited terminology and language in the summary of the invention. The terminology *integrated* and *partner* do not appear anywhere in the body of the Appellant's claim language. Furthermore, the Appellant has considerably narrowed the summary of the invention in contrast to the originally filed summary in the specification. (see pages 4 through 9 of the specification).

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The Appellant has failed to include a fourth ground of rejection as to claim 108 under 35 U.S.C. 103(a) as being unpatentable over Sloo in view of Slaikeu. However, Appellant has provided arguments as to this rejection (page 12 of the appeal brief).

(7) Grouping of Claims

No longer a requirement.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5895450	SLOO ET AL	8-1999
2002007362	COLLINS ET AL	1-2002
6766307	ISRAEL ET AL	7-2004
20010007106	SLAIKEU	7-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-10, 12-13, 15-17, 20-22, 25-27, 64-73, 93-99, 100,109, 111-112, and 115-117 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloo (US 5,895, 450) (hereinafter referred to as Sloo).

Referring to Claims 1 and 112:

Sloo discloses a method and a system for resolving an electronic commerce dispute involving one or more parties, comprising:

electronically providing access to an online dispute resolution system to allow at least one of the parties to initiate a filing of the dispute from an online marketplace (Figs. 1-6, col. 2, line 53 thru col. 3, line 7);

electronically receiving with the online dispute resolution system transaction data from the marketplace, wherein the transaction data describes transactions within the marketplace (Figs. 3-9; col. 2, lines 7-20)

receiving from at least one of the parties information related to the dispute (col. 2, lines 53-65; col. 3, lines 19-29) and

executing software with the online dispute resolution system (artificial intelligence (e.g. neural network linking)) to apply an online dispute resolution process that utilizes at least a portion of the transaction data from the market place and the information to assist the parties in resolving the dispute (col. 14, lines 2-16, lines 33-36, col. 3, lines 8-67).

Referring to Claim 2 and 64:

Sloo discloses a method and system further comprising automatically selecting one of two modes of resolving the dispute, the first mode requiring the online dispute resolution process being driven by an electronic agent to assist the parties in resolving the dispute and the second mode involving a human dispute resolution specialist (col. 13, line 50 thru col. 14, line 16, col. 14, lines 8-11, Figs. 1-9, col. 3, lines 8-67).

Sloo discloses plurality of methods to settle a dispute (Fig. 7). Sloo's methods for resolving disputes includes a first mode requiring the online dispute resolution process being driven by an electronic agent to assist the parties (negotiation) and the second mode involving a human dispute resolution specialist (judge/jury).

Referring to Claim 3:

Sloo discloses a method wherein the case-based reasoning system contains a history file (Fig. 2 (206-216), col. 9, lines 32-48, col. 14, lines 33-36).

Referring to Claim 4:

Sloo discloses a method and system wherein the history file contains patterns and precedents, further comprising applying the patterns and precedents to generate an outcome prediction (col. 10, line 54 thru col. 11, line 2).

Referring to Claim 5:

Sloo discloses a method further comprising presenting the outcome prediction to the parties to assist the parties in selecting the mode of resolving the dispute (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 14, lines 33-44, Fig. 2).

Referring to Claim 6:

Sloo discloses a method wherein the outcome prediction includes one or more likely outcomes and associated probabilities of occurrence (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 7:

Sloo discloses a method further comprising receiving settlement position from the parties (col. 2, lines 53-65, col. 4, lines 63-65, col. 7, line 66 thru col. 8, line 4).

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Referring to Claim 8:

Sloo discloses a method system further comprising automatically settling the dispute if the settlement positions satisfy a predetermined criteria (Automatic Negotiator – col. 10, lines 35-39).

Referring to Claim 9:

Sloo discloses a method wherein the predetermined criteria relates to a monetary settlement position (col. 7, line 66 thru col. 8, line 4).

Referring to Claim 10:

Sloo discloses a method wherein the predetermined criteria relates to non-monetary settlement position (col. 7, line 66 thru col. 8, line 4).

Referring to Claim 12:

Sloo discloses a method wherein the dispute resolution specialist generates a final recommended resolution (Fig. 7 (720)).

Referring to Claim 13:

Sloo discloses a method wherein the final recommended resolution is accepted by the one or more parties (col. 9, lines 50-52, col. 11, lines 37-42).

Referring to Claim 15:

Sloo discloses a method further comprising communication among the parties using a plurality of communication modes (Fig. 2, communication network, col. 6, lines 55-67):

Referring to Claim 16:

Sloo discloses a method wherein the communication modes include a public messaging mode in which communication is automatically shared between all of the parties and the dispute

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resolution specialist, and a private messaging mode in which communication for a given one of the parties is automatically shared only between that one of the parties and the dispute resolution specialist (Figs. 2, 7, col. 2, lines 7-9, col. 3, lines 30-38).

Referring to 17:

Sloo discloses a method wherein the communication mode is selected by the dispute resolution specialist (col. 6, lines 55-64). It is inherent that the mode of communication can be selected by the system or the users which would include the dispute resolution specialist.

Referring to Claims 20-21:

Sloo discloses a method further comprising providing visual cues when applying the dispute resolution process to automatically highlight agreements between the parties (col. 13, lines 12-17).

Referring to Claim 22:

Sloo discloses a method further comprising storing status data on participation of the parties in the dispute resolution process (col. 2, lines 7-20, col. 10, lines 54-64).

Referring to Claim 25:

Sloo discloses a method wherein the data relates to compliance of a participant to a result of the resolution of the dispute (col. 2, lines 7-20, col. 10, lines 53-64).

Referring to Claim 26:

Sloo discloses a method further comprising communicating the status data from the dispute resolution system to the marketplace and highlighting an offender based on the status information (col. 8, lines 50-65, col. 12, line 47 thru col. 13, line 24, cols. 17-18 –Example).

Referring to Claim 27:

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Sloo discloses a method further comprising providing a market-based system for assigning the dispute resolution specialist to a particular dispute (col. 8, lines 5-19).

Referring to Claim 72:

Sloo discloses a method further comprising determining a current mode of resolving the dispute; and automatically selecting a communication mode based on the determination (col. 10, line 54 thru col. 11, line 36, col. 6, lines 55-68).

Referring to Claim 73:

Sloo discloses a method further comprising providing the data to the parties to assist the resolution dispute (col. 10, line 54 thru col. 11, line 5)

Referring to Claim 100:

Sloo discloses a method further comprising maintaining a database that stores facts and outcome of previously resolved electronic commerce disputes, and wherein executing software apply a case-based reasoning system comprises:

searching the database to identify previously resolved disputes with facts that are similar to the case information (col. 4, lines 14-17, col. 10, line 54 thru col. 11, line 2);

identifying at least one likely outcome of the dispute based on the outcomes of the identified previously resolved disputes (col. 10, line 54 thru col. 11, line 5); and

presenting the identified likely outcomes to the parties as a potential resolution to the dispute to assist the parties in negotiating a resolution to the dispute(col. 10, line 54 thru col. 11, line 5, col. 11, lines 27-36).

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Referring to Claim 109:

Sloo discloses a method further comprising applying a case-based reasoning system to the information to produce a result for use in selection of a mode of resolving the dispute in accordance with an online dispute resolution process (col. 14, lines 32-44).

Referring to Claims 111 and 115:

Sloo discloses a method and system wherein the online dispute resolution system and marketplace have separate databases, the method further comprising: automatically electronically communicating the transaction data between the database on the online dispute resolution system and the database of the electronic marketplace (col. 6, lines 55-65).

Referring to Claim 65:

Sloo discloses a system wherein the server searches the database to identify previously resolved disputes with facts that are similar to the case information (col. 2, lines 7-20, lines 53-65, col. 4, lines 9-17, col. 10, lines 58-66).

Referring to Claim 66:

Sloo discloses a system wherein the server presents the result of the comparison by presenting the outcomes of identified previously resolved disputes (col. 10, line 58 thru col. 11, line 35).

Referring to Claim 67:

Sloo discloses a system wherein the server summarizes the outcome of identified previously resolved disputes (col. 10, line 58 thru col. 11, line 8, col. 14, lines 45-60).

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Referring to Claim 68:

Sloo discloses a system wherein the server presents the result of the comparison by generating an outcome prediction as a function of the facts and outcomes of the identified disputes, and presenting the outcome prediction to the parties (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 69:

Sloo discloses a system wherein the outcome prediction includes at least one likely outcome (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 70:

Sloo discloses a system wherein the outcome prediction includes associated probabilities of occurrence of the at least one likely outcome (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47-col. 13, line 23).

Referring to Claim 71:

Sloo discloses a system wherein the server presents the at least one likely outcome to the parties as a potential resolution of the dispute (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23, col. 14, lines 33-34).

Referring to Claim 93:

Sloo discloses a system wherein the server compares the case information to facts of previously resolved disputes to automatically select a resolution mode comprising one of (i) a direct negotiation mode that allows the parties to directly negotiate a resolution to the dispute via the computer network, (ii) a conciliation mode that allows the parties to negotiate the resolution

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to the dispute through a mediator (judge/jury), and (iii) mediation mode that allows a mediator to propose a resolution to the dispute (Figs. 1-9, col. 13, line 50 thru col. 14, line 16, col. 3, lines 8-67, col. 7, lines 29-40).

Referring to Claim 94:

Sloo discloses a system wherein the server provides a preprogrammed recommended resolution to at least one of the parties based on the comparison (col. 2, lines 53-65, col. 10 line 54 thru col. 11, line 35, col. 14, lines 32-60, col. 17, lines 5-15).

Referring to Claim 95:

Sloo discloses a system wherein the server:
performs an analysis of the dispute and presents pre-programmed recommended resolutions based on the analysis in the first mode (col. 10, line 54 thru col. 11, line 35;
performs a match of needs of the two parties as defined by the dispute to resolve the dispute in a second mode (col. 4, lines 14-17);
providing a medium for the parties to independently resolve the dispute in a third mode (col. 4, lines 19-37, col. 7, lines 29-40); and
assigns a dispute resolution specialist to resolve the dispute in a fourth mode upon failure to reach a recommended resolution (col. 8, lines 5-18).

Referring to Claim 96:

Sloo further discloses a system wherein the server provides a message exchange by which the dispute resolution specialist interacts with the parties to reach a recommended resolution (col. 6, lines 55-68, col. 9, lines 11-13).

Referring to Claim 97:

Sloo further discloses a system wherein the server automatically assigns the dispute resolution specialists (col. 8, lines 5-20).

Referring to Claim 99:

Sloo discloses a system further comprising a software program executing on the server to automatically assemble the case information from records provided by the parties, wherein the software module presents sample resolutions to the parties to aid the parties in resolving the case and presents the case information in a form that identifies areas of agreement between the parties (Fig. 1, col. 10, line 54 thru col. 11, line 5, col. 11, lines 21-36).

Referring to Claim 99:

Sloo discloses a system further comprising:
a first software program operating the server to assemble the case information from records provided by the parties (col. 3, line 26-28); and
a second software program operating on the server to assist a dispute resolution specialist in identifying similar cases from a historical database of past cases (col. 12, lines 25-32).

Referring to Claims 116 and 117:

Sloo discloses a system wherein the dispute resolution system and the marketplace are implemented at least in part as software executing on a computer system having data storage devices and wherein the dispute resolution system and the marketplace communicate via the computer system (Fig. 1, col. 3, lines 8-67).

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2. Claims 11, 14, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo as applied to claims 1 and 112 above, and further in view of Israel et al (US 6,766, 307) (hereinafter referred to as Israel).

Referring to Claim 11:

Sloo does not disclose a method wherein the dispute resolution specialist resolves the dispute by transitioning from a mediation stage to an arbitration stage. However, Israel discloses a method which allows for transition from mediation to arbitration. (col. 2, lines 40-51, col. 11, lines 29-39, col. 23, lines 36-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sloo as taught by Israel to get third party intervention when an agreement cannot be reached.

Referring to Claim 14:

Israel discloses a method further comprising creating a contract between the one or more parties stating the willingness to abide by the recommended resolution (col. 27, lines 12-21- Negotiation Agreement. – parties must agree to the terms and conditions).

Referring to Claim 28:

Israel disclose wherein the dispute resolution is provided as an insurance covering the transaction (col. 6, line 61 thru col. 7, line 5). Furthermore, the fact that the dispute resolution is provided as an insurance covering the transaction is considered to be non-functional descriptive language. The language adds little, if anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. Non-functional descriptive material cannot render non-obvious an invention that would have otherwise been obvious. This

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descriptive material is not related to the substrate and does not effect how the negotiation process is performed. Thus, this does not distinguish the claimed invention from the prior art, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994),

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the dispute resolution provided as insurance covering the transaction because such data does not functionally relate to the steps in the method claimed and the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to Claim 29:

Neither Sloo nor Israel discloses a method further comprising requiring a seller associated with the marketplace to be a registered subscriber to the online dispute resolution system Sloo discloses providing access to users(col. 4, lines 1-6) Israel discloses registering with the system (col. 3, lines 5-10, col. 8, line 57 thru col. 9, line 29) Moreover, this data is found to be non-functional descriptive data and therefore does not serve as a limitation on the claims to distinguish over the prior art. The language "registered subscriber" does not exhibit any functional interrelationship with the way in which the computing processes are performed.

Referring to Claim 30:

Sloo does not disclose membership data being communicated or automatically showing a visual indicia within the marketplace to indicate the availability of the dispute resolution system and the membership of buyers or sellers in the dispute resolution process.

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However, Israel discloses membership data being communicated (col. 5, line 64 thru col. 6, line 2) and automatically showing a visual indicia within the marketplace to indicate the availability of the dispute resolution system and the membership of buyers or sellers in the dispute resolution process (col. 8, line 58 thru col. 9, line 15 (hotlinks)).

Referring to Claim 31:

The fact that the visual indicia is a medallion that is a visible symbol of trust to increase the confidence of the buyers or the sellers in executing transaction within the marketplace is found to be non-functional descriptive data which will not distinguish the claimed invention from the prior art in terms of patentability.

3. Claims 110, 113 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo as applied to claims 1 and 112 above, and further in view of Collins et al (US 2002/0007362) (hereinafter referred to as Collins).

Referring to Claim 110, 113 and 114:

Sloo discloses the method of claim 1 and the system of claim 112. Sloo does not disclose a method and system further comprising electronically receiving with the online dispute resolution enrollment requests from the marketplace and automatically initiating enrollment of sellers or buyers within the dispute resolution system in response to the electronic requests from the marketplace.

However, Collins discloses a method and system further comprising electronically receiving with the online dispute resolution enrollment requests from the marketplace and automatically initiating enrollment of sellers or buyers within the dispute resolution system in

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response to the electronic requests from the marketplace (page 4 [0046]- registration stage which includes identification of relevant parties). Status data would inherently have to be maintained since Collins determines if the parties are eligible.

Furthermore, the fact that the user is a registered subscriber is found to be nonfunctional descriptive data. This does not alter how the method or system works and thus will not distinguish the claimed invention from the prior art in terms of patentability.

4. Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo as applied to claim 1 above, and further in view of Slaikeu (US Patent 2001/0007106).

Sloo discloses intervention by pre-qualified persons (judge/jury)(col. 8, lines 5-18)

Sloo does not a method further comprising:
training a dispute resolution specialist by requiring the dispute resolution specialist to experience transactions within online marketplaces including at least an auction site;
outputting simulated online dispute resolution cases to the dispute resolution specialists via the computer network to assess the skill of the dispute resolution specialists; and
assigning online disputes to the dispute resolution specialists only upon completion of the training and successful resolution of the simulated online dispute resolution cases.

However, Slaikeu discloses a method comprising training a dispute resolution specialist (page 3 [0025- 0026]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the training as taught in Slaikeu with the intervention of persons disclosed in Sloo so as to equip those who staff the programs with the necessary skills to resolve the disputes.

Furthermore, the Examiner takes Official Notice that online training is old and well known and has become an established business practice as is exemplified by online CLE classes, online graduate classes and testing. Furthermore, providing simulations of situations is also an old and well known way to train.

(11) Response to Argument

The First Ground of Rejection to Be Reviewed on Appeal (Claims 1-10, 12-13, 15-17, 20-22, 25-27, 64-73, 93-99, 100, 109, 111-112, and 115-117)

Independent claims 1 and 112:

Appellant's argues that Sloo fails to teach or suggest the claimed invention of claim 1 and 112. (Appellant's brief page 13).

The Examiner respectfully disagrees

Sloo discloses a *complaint handling apparatus (Figure 1)* for resolving *complaints related to goods, class of goods, services, and/or venders, the subjects of the complaints may be manufacturers, distributors, wholesalers, retailers or any other responsible persons or entities* (col. 3, lines 1-8) *with a plurality of access terminals* (col. 3, lines 8-11) (one or more parties) comprising:

the complaint handling apparatus 10 broadly includes a central computer 12 and a plurality of access terminals coupled with the central computer by a communication network 16; (col. 3, lines 8-39) (electronically providing access to an online dispute system); *the access terminals receive complaints and responses from the users* (col. 3, lines 18-20) (to allow one of the parties to initiate a filing of a dispute); *the users of the apparatus who file complaints may*

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include individuals, businesses, organizations or other entities and the complaints may relate to goods, classes of goods, services, and/or vendors, individuals, organizations or any object, the subject of the complaint may be individuals, manufacturers, distributors, wholesalers, retailers) (col. 3, lines 1-8) (wherein the dispute may be filed from an online marketplace);

receiving complaints and responses over the communication network (col. 3, lines 18-20) (electronically receiving with the online dispute resolution system transaction data (*responses*), *the users of the apparatus who file complaints may include individuals, businesses, organizations or other entities and the complaints may relate to goods, classes of goods, services, and/or vendors, individuals, organizations or any object, the subject of the complaint may be individuals, manufacturers, distributors, wholesalers, retailers* (from a marketplace) wherein *the apparatus receives complaints, notifies the subject of the complaints, receives responses from the subject* (transaction data from the marketplace), *stores the complaints and associated responses in individual data records* (col. 2, lines 56-59); see also, col. 2, lines 56-59; see Figure (500) and discussion as to Figure 5 (column 5, line 66 through column 6, line 14 and col. 6, lines 55-60) – *this portion of the program permits a subject to respond to a complaint issued against it. The subject may respond to the complaint by entering information in one of the access terminals and e-mailing or transmitting the information to the central computer by way of the communication network*).

the access terminals 14 receive complaints and responses from the user, deliver them to the central computer 12 (column 2, lines 56-57, column 3, lines 19-29) (receiving from at least one of the parties information (complaint) related to the dispute)

each access terminal includes conventional memory and software for communicating with and interpreting the data sent from the central computer (col. 3, lines 8-67); the complaint handling apparatus may draw from available data and be able to recognize the object and the situation and inform the participant about what action to take; the complaint handling apparatus may, based on artificial intelligence (e.g. neural network linking) be able to predict the best actions given the situation (col. 14, lines 2-16 and lines 33-36); Appellant is also directed to column 13, line 59 through col. 14, line 2 wherein Soo discloses that *the complaint handling apparatus would, through artificial intelligence processing of available data, recognize recorded objects, predict a satisfaction level for the participant regarding the object, recommend a best behavior regarding the interaction; this done automatically)* (executing software with the online dispute resolution system (*artificial intelligence (e.g. neural network linking)*) to apply an online dispute resolution process that utilizes at least a portion of the transaction data from the market place and the information to assist the parties in resolving the dispute).

Appellant argues that Sloo fails to teach or suggest (1) *an online marketplace*, (2) *electronically receiving with the online dispute resolution system with the online dispute resolution system transaction data from the marketplace*, (3) *at least a portion of the transaction data from the marketplace* (page 13 of the appeal brief).

The Examiner respectfully disagrees.

First, Sloo discloses filing of the dispute from an online marketplace. Sloo discloses an complaint handling apparatus (10) (col. 2, line 53) constructed with access terminals 14 for receiving complaints and responses from users (col. 3, lines 18-19) over a communication

network (16) (col. 3, line 31) wherein the users can be retailers, manufacturers, distributors, wholesalers (col. 2, line 66 through col. 3, line 7).

Secondly, Sloo discloses electronically receiving with the online dispute resolution system transaction data from the marketplace (retailer, wholesaler, complaints relating goods and services) (responses to the complaints are received – see Figure 5 (500). If a retailer responds to a complaint via the complaint handling apparatus, transaction data is being received from the market place. Electronically receiving transaction data would include data entered manually into a computer and would include any communication over the network.

Thirdly, Sloo discloses a process that utilizes at least a portion of the transaction data from the market place. The complaint handling apparatus of Sloo may draw from available data (this includes complaints and responses) and inform the Appellant about what action to take (col. 3, lines 18-29, col. 14, lines 2-16), thus using a portion of the retailers marketplace transaction data to make this determination

As for the Appellant's contention that Sloo fails to show certain features of the Appellant's invention (page 14 of the Appellant's appeal brief) it is noted that the features upon which Appellant relies (i.e., an online dispute system *integrated with a partner system*, wherein the partner system is an online marketplace; an *electronic integration of an online marketplace with a dispute resolution system*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant contends that with respect to independent claim 112, Sloo fails to teach or suggest an online dispute resolution system that electronically receives transaction data from a marketplace.

The Examiner respectfully disagrees.

First, Appellant states on page 11 of the specification that *marketplace 106* can be a physical mall or marketplace or a website such as an online centralized trading. Electronically receiving data would include data entered manually and transmitted through a communication network.

Secondly, claim 112 is a system claim. Appellant is erroneously trying to define the system by what it does rather than the specific structure. Sloo clearly discloses an online dispute resolution system (*complaint handling apparatus 10*, col. 2, lines 53-56) that electronically receives transaction data (access terminals 14 *receive complaints and response from the users and receive transmissions from the central computer*, col. 3, lines 18-20), the system executing software (*software for communicating with and interpreting the data*, col. 3, lines 24-27; *the apparatus is capable of drawing from available data and informing the participant about what action to take*) that utilizes the transaction data to assist in the resolution of the dispute, and a system which provides status data (*the central computer is programmed to monitor and rate the conduct and performance and provide access to data records*, col. 2, lines 7-20)

Also, in regard to Claim 112, the Appellant states that Sloo does not teach or suggest in integrated system. It is noted, one again, that the feature upon which Appellant relies (i.e., an *integrated system*) is not in the body of the claim.

Dependent Claims 111 and 115:

Appellant argues that Sloo fails to teach or suggest automatically electronically communicating the transaction data between the database of the online dispute resolution system and the database of the electronic marketplace as set forth in dependent claims 111 and 115 and that the Examiner is in error in asserting that Sloo describes an online dispute resolution system that comprises a data manager software to automatically communicate data between a database of the online dispute resolution system and a database of the electronic market.

The Examiner respectfully disagrees.

Sloo discloses a method and system wherein the subject (retailer/marketplace) responds to the complaint (the response) by entering information (transaction data) into one of the access terminals by emailing or transmitting the information to the central computer which includes conventional memory (databases) by way of the communication network (col. 6, lines 55-60) (see also column 3, lines 8-17, lines 18-30 *access terminals 14 receive complaints and responses from users, delivers them to the central computer and receives transmissions from the central computer*, each access terminal includes conventional memory (*databases*) and software for communicating with and interpreting the data.

Thus, Sloo discloses communicating data between a complainant and a responder (retailer) with the aid of a computer via an electronic communication network. The Examiner asserts that the fact that the online dispute resolution system and the marketplace have separate databases does not mean that they have to be separate computers. The information, i.e., the complaint and a response (data describing the transaction from the responder) are entered manually via access terminals (14) and then stored in the central computer (12) of the complaint

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handling apparatus (10) (*online dispute resolution system*) wherein the access terminals include conventional memory (databases) and *software* for communicating with and interpreting the data sent *from* the central computer (*data manager software*).

Furthermore, it is not clear to the Examiner that the Appellant's transaction data was not also manually entered into the computer at some point in time.

Dependent claims 2 and 64:

Appellant presents arguments as to comments presented by a previous Examiner in prior previous Office Action dated September 12, 2003. However, the September 12, 2003 is not the most recent Office Action. The previous Examiner also provided a rejection on March 12, 2004 and subsequently Appellant filed a Request for Continued Examination. The most recent amendments and arguments were addressed in the Office Action dated September 7, 2004. Therefore, the Examiner does not consider the comments as to the September 12, 2003 Office Action to be relevant.

As to the September 7, 2004 rejection, the Appellant argues that Sloo does not disclose automatically selecting a mode for the parties to resolve a dispute, the first mode being driven by an electronic agent to assist the parties and the second mode involving a human as set forth in dependent claims 2 and 64:

The Examiner respectfully disagrees.

Sloo discloses a method and system comprising automatically (col. 13, lines 50-558 -*the entire complaint handling apparatus complaint resolution decision process might be completely automated, the complaint handling apparatus with the two modules above, would through*

artificial intelligence processing of available data, recognize recorded objects ...recommend a best behavior regarding the interaction, see also column 15, lines 32-38, the complaint handling apparatus may automatically determine, through artificial intelligence, whether a reported complaint is a violation and should be held) selecting one of two modes of resolving the dispute (a participant may encounter objects previously encounter by others and the complaint handling apparatus may draw from available data and be able to recognize the object and the situation and inform the participant about what action to take col. 14, lines 2-16), the first mode requiring the online dispute resolution process being driven by an electronic agent to assist the parties in resolving the dispute (Automatic Negotiator (Figure 7 (702), also see column 12, lines 47-61 the complaint handling apparatus would identify offenses and violations as they occur and process them automatically)) and the second mode involving a human dispute resolution specialist (Figure 7 (712) Judge/Jury).

As for the Appellant's comments in the first paragraph of page 17, the Examiner does not consider these comments to be relevant.

Sloo clearly discloses a method and system for complaint handling (resolving disputes) (Page 2 lines 54-56) over a complaint handling apparatus which includes a computer (Figure 1 and page 3, lines 8-30) wherein there are at least two modes (Figure 7), the first mode requiring the online dispute resolution process to be driven by an Automated Negotiator (electronic agent) which allows the apparatus to determine a resolution to the dispute and a second mode involving a Judge/Jury (human dispute resolution specialist).

The Second Ground of Rejection to be Reviewed on Appeal (Claims 30-31)

Dependent Claims 30-31:

In response to Appellant's first argument that there is no suggestion to combine Israel with Sloo, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the reference (col. 23, lines 39-42).

In response to Appellant's argument that there must be a reasonable expectation of success, Collins teaches a dispute resolution system and method which is field of Appellant's endeavor and the system and method is pertinent to the particular problem with which the Appellant was concerned and thus there would be a reasonable expectation of success.

Once again, at the top of page 18, Appellant's presents arguments as to claim 30 stating that the references fail to show certain features of Appellant's invention. It is noted that the features upon which Appellant relies (i.e., claim 30 illustrates even further *integration of data* and *functionality* between the online dispute resolution system and the marketplace) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant argues that Israel fails to teach or suggest the limitations of dependent claims 30 and 31.

The Examiner respectfully disagrees.

Israel discloses a system and method for providing complete non-judicial dispute resolution which requires each party to pay a certain amount to participate in the resolution proceeding (col. 5, line 64 thru col. 6, line 2) (communicating membership data).

The system of Israel can be accessed by a hot link, which is identified as embedded URL code or other indication means, embedded within the web site of another entity so that the user actively viewing the web site can easily select the hot link (automatically showing visual indicia) and wherein the entity can be engaged in a business where disputes occur, such as, for example, a web site which sells goods or services (col. 9, lines 1-7)(marketplace).

The fact that the indicia is a medallion used for the purpose of increasing the confidence of buyers and sellers was determined by the Examiner to be non-functional descriptive data which would not distinguish the Appellant's invention from the prior art in terms of patentability.

Furthermore, Appellant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Appellant comments on the response dated June 13, 2003 again and states that Appellant submitted a declaration under 37 CFR 1.132 describing objective evidence and secondary

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consideration. The Appellant then states that to date the Examiner has failed to consider the evidence.

Upon review of the record it is determined that the previous Examiner did fail to make a written record of consideration the of the 132 declaration. However, since the previous Examiner last examined the application, the Appellant has filed a Request for Continued Examination and Appellant's submission filed on April 12, 2004 has been entered. The April 12, 2004 response made no mention of the 132 declaration in the Remarks. Furthermore, since the June 13, 2003 date of the submission of the declaration, the Appellant has made considerable amendments to claims 30 and 31. Thus, the declaration would not be relevant to the claim language that is now on appeal.

Moreover, upon reviewing the declarations under 37 CFR 1.132 it is determined that the declarations are insufficient to overcome the rejection of claims 30 and 31 based upon Sloo in view of Israel because:

The declarant, Stephen Abernathy, is the CEO of the assignee and thus any declaration by this person would be considered to be biased since the declarant would have a financial interest in the grant of a patent on this invention.

The first seven pages of the declaration appear to be merely opinion evidence and unsupported or uncorroborated allegations.

The Appellant has failed to link the alleged commercial success to the subject matter in the claimed language.

The Appellant has failed to provide any evidence as to the allegation of long felt need. There is no evidence that a problem existed in the art for a long period of time and that the claimed invention solved the problem.

The Appellant has failed to provide any objective evidence supporting patentability of the invention.

It is unclear to the Examiner what the declaration of Ethan Katsh is trying to establish or what the Appellant is relying on the declaration to prove.

The Third Ground of Rejection to be Reviewed on Appeal (Claims 110 and 113)

Dependent Claims 110 and 113:

The Appellant argues that Collins fails to teach or suggest receiving enrollment requests from the marketplace and initiating enrollment of sellers or buyers within the dispute resolution system in response to the request.

The Examiner respectfully disagrees.

Collins discloses an apparatus and method for facilitating agreement over a network (Figure 1a and page 3 [0037])) wherein once the steps are taken by the parties in communication with the central processor to begin negotiation, step 300 begins the negotiation initialization state which might also be called the registration state as it includes identification of relevant parties and a determination of eligibility to participate (page 4 [0046] and Figure 2). In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

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See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Fourth Ground of Rejection to be Reviewed on Appeal (Claim 108)

Independent Claim 108:

Although not listed in the Appellant's grounds for rejection to be reviewed on appeal, the Appellant has interjected an argument as to dependent claim 108 under 35 U.S.C. 103 (a) as being unpatentable over Sloo in view of Slaikeu.

Appellant argues that Slaikeu does not describe any form of an electronic dispute resolution system that assists parties in handling dispute, let alone an electronic dispute system that is integrated with a partner system.

First of all, one again, Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., integrated with a partner system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

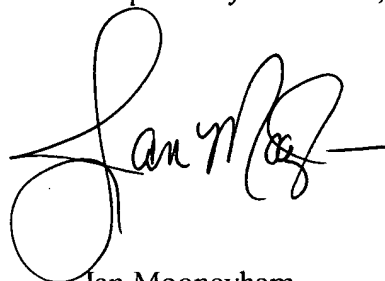
In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Dependent claim 108 was rejected as being unpatentable over Sloo in view of Slaikeu.

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Slaikeu discloses an expert system for analysis of organizational conflict handling procedures with a training element for training in the core skill of dispute resolution (see page 3 [0025-0026]) as set forth in dependent Claim 108.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a large, stylized initial "J" and a horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
Art Unit 3629

JM
April 29, 2005

Conferees
John Weiss, SPE 3629

John Weiss 5-2-05

Dean Nguyen, Primary Examiner 3629

Dean

SHUMAKER & SIEFFERT, P. A.
8425 SEASONS PARKWAY
SUITE 105
ST. PAUL, MN 55125